

REMARKS

Claims 1 through 18 are pending in this application. Claim 1, 4, 5 and 13 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. The Applicant appreciates the Examiner's indication of allowance of claims 4 through 18 and the allowability concerning claims 2 and 3.

I. Specification

The specification was amended to correct a minor error. No new matter was added.

II. Claim Rejections - 35 USC § 103

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references

when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoo et al. (Yoo) (US 5,809,367) in view of Kamei (US 6,247,788). The Applicant respectfully traverses.

The Examiner stated that Yoo does not clearly teach editing by reducing the number of pixels of the image data at a certain rate when the detected paper is thick but that Kamei discloses an inkjet recording apparatus that includes editing by reducing the number of pixels of the image data at a certain rate when the detected paper is thick (col 13, lines 20-31).

However, looking at col. 13, lines 20-31, Kamei states, "When a thick paper having a thickness greater than 0.5 mm or an OHP film is used, the size of the banding pattern table is set to 4x80", but when a paper of "thickness of less than 0.5 mm or regular paper is used, the size of the banding pattern table is set to '3x64'". Therefore, Kamei does not teach of reducing the number of pixels as seen in the present invention when the paper is thick, but of increasing.

Furthermore, Kamei as combined with Yoo, does not teach or suggest reducing the number of pixels at a "certain rate" as seen in claim 1. Kamei only gives examples of banding pattern table when there is a standard paper or thick paper, but no actual rate.

Moreover, col. 3, lines 3-7 of Kamei states that the banding pattern table is defined by a matrix "R.times.C", where R is a number of rows of the dots included in said overlapping area and C is a number of dots arranged in the main scanning direction. The table relates to printing highly staggered, that is, overlapping swaths to overcome the problems of banding patterns on the printed image. This is a problem that occurs in certain inkjet printers. Figures 10A through 12B of Kamei shows the 2x2, 2x3 and 3x2 matrix banding pattern. Clearly, the image data itself does have its pixels reduced. Therefore, the overlapping swaths of print does not teach of editing by reducing the number of pixels of the image data.

The Examiner further stated that Yoo as combined with Kamei teaches of transmitting the edited image data to the laser scanning unit and performing the printing work for the edited image data (col 6, lines 36-40, Yoo).

However, Yoo only teaches of printing the input image and not of transmitting the edited image and Kamei only teaches of increasing the swath size. Therefore, the combination of references does not teach of transmitting the edited image data that has its pixels reduced being transmitted to the laser scanning unit.

Moreover, Kamei since it involves an inkjet recording apparatus does not teach of sending the image data using the band pattern table to a laser scanning unit.

The Examiner further states that therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Yoo to include editing by reducing the number of pixels of the image data at a certain rate when the detected paper is thick as taught by Kamei because it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Yoo by the teaching of Kamei to allow that the number of dots in the overlapping area to be changed in accordance with the thickness of the recording paper used as taught by Kamei in col 13, lines 20-31.

Respectfully, the motivation to combine is improper. The showing must be "clear and particular" without broad generalized conclusory statements. *In re Dembiczak*, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). There must be specific statements showing the scope of the suggestion, teaching, or motivation to combine the prior art references. *Id.* at 1000. There must be an explanation to what specific understanding or technical principle would have suggested the combination of references. *Id.* Respectfully, the motivation given by the examiner of "to allow that the number of dots in the overlapping area to be changed in accordance with the thickness of the recording paper used as taught by Kamei in col 13, lines 20-31", is a reiteration of the teaching used from Kamei to combine with Yoo in order to reject claim 1 of the present invention as mentioned above.

Moreover, Kamei should not be combined with Yoo since Kamei involves an inkjet printer while the present invention in claim 1 claims for example transmitting edited image data to a laser scanning unit and also mentions electrostatic latent image. Therefore Kamei involves a non-

analogous art. According to MPEP §2141.01(a):

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

(underlining added for emphasis)

Later, in MPEP §2141.01(a), there is a discussion about the *In re Oetiker* case:

Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The court held the reference was

not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.

(underlining added for emphasis)

Respectfully, therefore, according to MPEP §2141.01(a) and cases such as *In re Oetiker* cited above, the reference of Kamei and therefore the combination is not within the field of applicant's endeavor, and is not reasonably pertinent to the particular problem with which the inventor was concerned because it has to be shown that person of ordinary skill, seeking to solve a problems of the present invention would reasonably be expected or motivated to look to inkjet printers which have a different set of problems and structure. Therefore, since Kamei is not an analogous prior art, the combination does not render the present invention as obvious.


III. Allowable Subject Matter

The applicant appreciates the examiner's indication of allowability pertaining to claims 2 and 3. In accordance with 37 C.F.R. § 1.111(b), the applicant respectfully requests that the examiner temporarily hold objections and requirements as to form in abeyance until the remarks and amendments in this Amendment are considered by the examiner.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

A fee of \$110.00 is incurred by filing of a petition for one month extension of time. Applicant's check drawn to the order of the Commissioner accompanies this Amendment. Should the check become lost or detached from the file, the Commissioner is authorized to charge Deposit Account No. 02-4943 and advise the undersigned attorney accordingly. Also, should the enclosed check be deemed to be deficient or excessive in payment, the Commissioner is authorized to charge or credit our deposit account and notify the undersigned attorney of any such transaction.

Respectfully submitted,



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